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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,026	06/13/2002	Hendrik Antonius Hoogland	294-121 PCT/US	9089

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EXAMINER

OMGBA, ESSAMA

ART UNIT	PAPER NUMBER
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3726

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/069,026

Applicant(s)

HOOGLAND, HENDRIK  
ANTONIUS

Examiner

Essama Omgba

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 20-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 10-19 is/are rejected.
- 7) ☒ Claim(s) 7-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of the invention of Group I, claims 1-19, in the response dated March 19, 2004 is acknowledged.

### ***Information Disclosure Statement***

2. The information disclosure statement filed February 19, 2002 fails to comply with 37 CFR 1.98(a)(1), which requires a list of all patents, publications, or other information submitted for consideration by the Office. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Specification***

3. The disclosure is objected to because of the following informalities: on pages 2-7, reference to claims to disclose the invention is not proper. A description of the invention in the specification should not be substituted by referring to the claims. Furthermore the original numbering of the claims is not necessarily the final numbering. On page 3, line 35, "is" second occurrence should read --be--

Appropriate correction is required.

4. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

### ***Claim Objections***

5. Claims 8 and 9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 8 and 9 recite the same limitations as claim 7.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74

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(Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 1 and 11 recite the broad recitation "placement in a mold", and the claims also recite "in particular an injection mold" which is the narrower statement of the range/limitation.

In claims 1 and 11, the phrase "to be referred to as label" renders the claims indefinite since "part of a strip of film", "the enclosed part cut loose" and "the part overlying the blanking opening" are all being referred to as "label". The method steps also need to be positively recited.

In claim 1, the phrase "in particular slightly pressed upon" renders the claim indefinite.

Claim 1 recites the limitation "the film web" in 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation " the desired label" and "the label-forming part" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "the label-forming part" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Applicant should note that the preceding are just examples of such 112, 2<sup>nd</sup> paragraph problems in the claims. Applicant is requested to correct all the 112, 2<sup>nd</sup> paragraph problems in all the claims in order to conform to US rules.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4 and 10-17, *as best understood by the examiner*, are rejected under 35 U.S.C. 102(b) as being anticipated by Dobler (US Patent 5,919,414).

With regards to claims 1 and 11, Dobler discloses a method for manufacturing labels 29 for placement in an injection mold (column 1, lines 4-8) wherein a web of film 22 is supplied and is placed on a supporting carrier 17 wherein part of the web is cut out (column 1, lines 8-11) and a retaining element 33 is applied to a second side of the cut-out web and the cut-out web is picked up from the carrier (see column 6, lines 3-14).

For claim 2, see figure 1, elements 29 and 33.

For claim 3, see column 6, lines 12-14.

For claims 4 and 16, see column 1, lines 62-67 and column 8, lines 8-13.

For claims 10 and 17, see column 3, lines 60-67 and column 4, lines 1-20.

For claims 12 and 13, see column 5, lines 1-28. Applicant should note that the restoring spring force will ensure that the retaining element is not loaded.

For claims 14 and 15, Applicant should note that it is inherent that the film web will be printed prior to forming the labels and that the print will be on the appropriate surface.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 5, 6, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dobler.

For claims 5 and 6, Dobler discloses a method for manufacturing labels for placement in an injection mold as shown above except for the labels being taken hold of using static charge or adhesion. However it would have been obvious to one of ordinary skill in the art at the time the invention was made that using static charge or adhesion to take hold of the labels on the retaining element is an obvious matter of design choice wherein no stated problem is solved or unexpected results obtained in using static charge or adhesion versus vacuum force as taught by Dobler as long as the label is held without crease on the retaining element.

For claim 18 and 19, Applicant should note that the thickness of the film web lends no patentable weight to the method being claimed and also Dobler's method is capable of using film web of that particular thickness.

***Allowable Subject Matter***

13. Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Essama Omgba whose telephone number is (703) 305-2915. The examiner can normally be reached on M-F (10-7:30) First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

eo  
May 15, 2004

A handwritten signature in black ink, appearing to be "J. M. [unclear]", is located in the middle right section of the page.